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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,110

01/16/2004

Marc Vincent Marini

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7346

24978 7590 10/16/2007  
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EXAMINER

TALBOT, MICHAEL

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

10/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/760,110

Applicant(s)

MARINI ET AL.

Examiner

Michael W. Talbot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-14 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. In view of the appeal brief filed on 02 July 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakiuchi et al. 2002/0017026. Kakiuchi et al. 2002/0017026 shows in Figures 1-7 a tool-less blade clamping apparatus (10) for a reciprocating tool having a plunger (2) with at least one radial aperture (2e) and a blade receiving slot (2a) at its forward end for receiving a blade (3) having a shank portion (Fig. 6) with a hole (3a) and at least one outwardly extending shoulder (3c). Kakiuchi et al. 2002/0017026 shows the shank configured to be inserted in the slot (Figs. 3,5,6) and the apparatus configured to be attached to the plunger and having an opening (Fig. 6) for receiving the blade shank therein. Kakiuchi et al. 2002/0017026 shows the apparatus having an unclamped position and a clamped position wherein the shank portion of the blade can be inserted into the opening when in the unclamped position and securely retained therein when in the clamped position (Fig. 5 and paragraphs [0055], [0060] and [0061]). Kakiuchi et al. 2002/0017026 shows the apparatus being biased via spring (12) toward the clamped position (paragraph [0049]) and being operable to maintain its unclamped position via a releasable retaining mechanism (operating sleeve 11, spring 12, blade clamp slot 16a, lock control slot 16b, pin 22) when placed in said unclamped position (paragraph [0055]). Kakiuchi et al. 2002/0017026 shows the apparatus being released when the at least one shoulder (3c) of the blade shank portion engages the apparatus as the shank portion is inserted into the opening and slot a predetermined distance to place the apparatus in the clamped position (paragraph [0055]) and the apparatus engaging the at least one shoulder and pushing the blade shank portion outwardly (via block 20 and spring 21) when moved in the unclamped position.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al. '548. Kramer et al. '548 shows in Figures 1-13 a tool-less blade clamping apparatus (41) for a reciprocating tool having a plunger (44) with at least one radial aperture (64) and a blade receiving slot (62) at its forward end for receiving a blade (42) having a shank portion (48) with a

hole (82) and at least one outwardly extending shoulder (95). Kramer et al. '548 shows the shank configured to be inserted in the slot, the apparatus configured to be attached to the plunger and having an opening (central apertures of cam collar 56, sleeve 58 and collar housing 59) for receiving the blade shank therein. Kramer et al. '548 shows the apparatus having an unclamped position (Fig. 7) and a clamped position (Fig. 6) wherein the shank portion of the blade can be inserted into the opening when in the unclamped position and securely retained therein when in the clamped position. Kramer et al. '548 shows the apparatus being biased via spring (54) toward the clamped position (col. 5, line 54-56) and being operable to maintain its unclamped position via a releasable retaining mechanism (cam collar 56 and collar housing 59 rotated to unclamped/release position by a user/operator and held there) when placed in said unclamped position (Fig. 7). Kramer et al. '548 shows the apparatus being released when the at least one shoulder of the blade shank portion engages the apparatus (col. 5, lines 59-61) as the shank portion is inserted into the opening and slot a predetermined distance (col. 5, line 54 through col. 6, line 4) to place the apparatus in the clamped position and the apparatus engaging the at least one shoulder and pushing the blade shank portion outwardly when moved in the unclamped position (col. 4, line 40-56).

With regards to claim 1, it has been held that a recitation that an element is "being operable to" perform a particular function is not a positive limitation and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the above reference, the apparatus is being operable to maintain its unclamped position when placed in said unclamped position by simply a user/operator holding the cam collar 56 and collar housing 59 in place.

***Allowable Subject Matter***

5. The following is a statement of reasons for the indication of allowable subject matter:

Claims 5-14 are allowed.

Claim 5 is the sole independent claim.

The prior art of record fails to anticipate or make obvious the claimed construction of a tool-less clamping apparatus for a reciprocating tool of the type which has a reciprocating plunger having (1) a hollow cylindrical inner sleeve configured to fit around the plunger having structure engaging the slot so that the inner sleeve is axially movable and non-rotatable relative to the plunger and having at least one outwardly extending protrusion and an inner ramp surface at its forward end that is axially oriented and inclined radially outwardly in the rearward direction, (2) a hollow cylindrical outer sleeve configured to fit around the inner sleeve and move circumferentially and axially relative thereto, said outer sleeve having a circumferentially extending slot with a transverse axially extending slot extension and at least one recess in the inside surface thereof forming a diagonal wall oriented toward the front of said outer sleeve from said end of said elongated slot that has said transverse extension to said opposite end for contacting said protrusion therein, said recess diagonal wall causing said outer sleeve to rotate relative to said inner sleeve responsive to forward axial movement of said inner sleeve when the blade is inserted into the slot, and (3) a pin secured to the plunger and engaging said slot of said outer sleeve and limiting rotational movement of said outer sleeve between the ends of said circumferentially extending slot and axially between the ends of said transverse axially extending slot extension, solely or in combination, with the reciprocating plunger having at least one radially oriented aperture and a blade receiving slot, a blade having a shank portion with a hole and at least one outwardly extending shoulder located between the distal end of the shank and a main portion, a compression spring positioned to bias the inner sleeve forward, a detente

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positioned in the plunger rod aperture configured to engage the aperture in the blade, the apparatus having an unclamped position wherein the blade can be inserted and a clamped position wherein the blade can be securely retained therein, at least one spring biasing apparatus towards the clamping position, a releasable retaining mechanism for holding the apparatus in its unclamped position when placed in the unclamped position,

Kakiuchi et al. '039 is the closet art of record.

Kakiuchi et al. '039 lacks (1) a hollow cylindrical inner sleeve configured to fit around the plunger having structure engaging the slot so that the inner sleeve is axially movable and non-rotatable relative to the plunger and having at least one outwardly extending protrusion and an inner ramp surface at its forward end that is axially oriented and inclined radially outwardly in the rearward direction, (2) a hollow cylindrical outer sleeve configured to fit around the inner sleeve and move circumferentially and axially relative thereto, said outer sleeve having a circumferentially extending slot with a transverse axially extending slot extension and at least one recess in the inside surface thereof forming a diagonal wall oriented toward the front of said outer sleeve from said end of said elongated slot that has said transverse extension to said opposite end for contacting said protrusion therein, said recess diagonal wall causing said outer sleeve to rotate relative to said inner sleeve responsive to forward axial movement of said inner sleeve when the blade is inserted into the slot, and (3) a pin secured to the plunger and engaging said slot of said outer sleeve and limiting rotational movement of said outer sleeve between the ends of said circumferentially extending slot and axially between the ends of said transverse axially extending slot extension.

Although it is well known to have a actuation sleeves and a bayonet pin, there is no teaching in the prior art of record that would, reasonably and absent impermissible hindsight, motivate one having ordinary skill in the art to so modify the teachings of Kakiuchi et al. '039 to

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include the above described three features with there specific functions. Thus, for at least the foregoing reasons, the prior art of record neither anticipates nor rendered obvious the present invention as set forth in independent claim 5.

### ***Response to Arguments***

6. Applicant's arguments filed 02 July 2007 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the Kramer et al. '548 reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the apparatus is maintained in an unclamped position via a "detent position", see page 5 second paragraph, or a "releaseable retaining mechanism", see page 6, second paragraph) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as broadly recited in claim 1, the Kramer et al. '548 reference only needs to meet the claim limitation of "said apparatus being configured to maintain its unclamped position when placed in said unclamped position". There is no structure relied upon as claimed to maintain the apparatus in the unclamped position, especially no reference to a "detent position", it just needs to be capable of being maintained in the unclamped position which the Kramer et al. '548 reference clearly teaches via cam collar 56 and collar housing 59 rotated to unclamped/release position by a user/operator and held there.

8. With regards to the legal basis in as much as citation(s) to MPEP or CFR sections for the phrase "being configured to" or similar phrases, the applicant is respectfully directed to MPEP, sections 2106 and 2111.04.

Furthermore, Applicants finding of the USPTO website for the phrase "configured to" rendering 206,446 patents since 1975, it is not being suggested that this phrase or similar phrases are not present in US patents, it is however most probable that these phrases were not relied upon solely for patentability.

9. Applicant's arguments, see pages 8-9, filed 02 July 2007, with respect to claim 4 and references Kramer et al. '548 in view of Kakiuchi et al. '039 have been fully considered and are persuasive. Therefore, the rejection of claim 4 with respect to references Kramer et al. '548 in view of Kakiuchi et al. '039 has been withdrawn.

#### ***Conclusion***

10. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT

Examiner

10 October 2007



MONICA CARTER  
SUPERVISORY PATENT EXAMINER